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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,078	09/24/2001	Rafael Pi Subirana	H-3734 PCTUS	9173

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COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER

BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/857,078

Applicant(s)

PI SUBIRANA ET AL.

Examiner

Barbara P. Badio, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-20 is/are allowed.
- 6) ☒ Claim(s) 21-26, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**Final Office Action on the Merits**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

2. **The rejection of claims 21 and 22 under 35 USC 102(b) over Cremlyn et al. or Ramirez et al. are maintained.**

Applicant maintains that the claimed sterol phosphates are different from the prior art compounds. According to applicant, the differences in the processes used to make each product help to highlight the differences in the end products themselves and that the process results in a different product. Applicant's argument was considered but not persuasive for the following reason.

As stated in the previous Office Action, the patentability of a product does not depend on its method of production. Thus, applicant argument of the presence of impurities is noted but irrelevant. The examiner notes (a) that the cited references teach the production as well as identify the specific sterol phosphates and (b) the instant claims encompass the sterol phosphates taught by the cited references.

For this reason and those given in previous Office Actions, the rejection of claims 21 and 22 under 35 102(b) over Cremlyn et al. or Ramirez et al. are maintained.

***Claim Rejections - 35 USC § 103***

**3. The rejection of claims 23-26, 29 and 30 under 35 USC 103(a) over Simonnet ('433) and Ribier et al. ('250) in combination.**

Applicant argues Simonnet (a) does not teach or suggest the addition of a sterol phosphate to an already formed cosmetic formulation base and that according to the teachings of the reference, the only reason one of ordinary skill in the art would be motivated to incorporate an amphiphilic lipid into a composition would be if the composition contained lamellar based lipid vesicles which could be stabilized by the incorporation of such an additional lipid and (b) does not provide motivation toward the selection of cholesterol phosphates over any other amphiphilic lipids. According to applicant, Ribier fails to remedy the deficiencies of Simonnet. Applicant's argument was considered but not persuasive for the following reasons.

The claims are drawn to a cosmetic preparation "comprising" a formulation base and a sterol phosphate. The use of the transitional term "comprising", which is synonymous with "including", "containing" or "characterized by" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (see MPEP 2111.03). Thus, the instant claims encompass the composition taught by the prior art even though, the prior art composition contains lamellar based lipid vesicles. The motivation to combine the two references is based on the teachings of the prior art of the use amphiphilic ionic lipids, such as sterol phosphate, to enhance the stability of the dispersion taught by the prior art.

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Applicant also argues that the prior art does not provide motivation toward the selection of cholesterol phosphates over any other amphiphilic lipids. Applicant's argument is noted, however, the issue is whether the prior art makes obvious the use of cholesterol phosphates in cosmetics as recited by the instant claims. Based on the teachings of Simonnet and Ribier, the use of amphiphilic lipids in cosmetic compositions, such as cholesterol phosphates, would have been obvious to the skilled artisan at the time of the present invention.

For these reasons and those given in previous Office Actions, the rejection of claims 23-26, 29 and 30 under 35 USC 103(a) over Simonnet ('433) and Ribier et al. ('250) in combination is maintained.

#### ***Allowable Subject Matter***

4. Claims 10-20 are allowed.
5. Claims 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Telephone Inquiry***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 6:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
December 29, 2003